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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER

29M1/0805

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ART UNIT PAPER NUMBER

2901

13

DATE MAILED: 08/05/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 5/7/97
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) _____ is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) _____ is/are rejected.
- ☒ Claim(s) title, drawing is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 2901

1. Applicant's amendment received 5/7/97 is acknowledged. The rejection of the claim under 35 U.S.C. 112, second paragraph is withdrawn in view of the cancellation of "or the like" from the claim. It is noted that applicant now refers to the embodiment shown in original Fig.7 as an enlarged view of the first embodiment.
2. Applicant's amendment to the title is not appropriate because the claim is directed to an icon, not a computer display. Furthermore, the title is inconsistent among the figure descriptions, the claim and the remainder of the application. For clear identification of the claimed subject matter, the title must be amended throughout the application, original declaration excepted, to read: ICON FOR A COMPUTER DISPLAY. Correction is required. 35 U.S.C. § 112 paragraph 2, 37 C.F.R. § 1.117.
3. The drawing is objected to for the following reason:

Office action, paper #11, required cancellation of original Figs.3-6, 8 and 9, and renumbering of elected Figs.1, 2, and 7 as Figs.1-3, respectively. No proposed drawing corrections have been submitted.

Correction is required. 35 U.S.C. § 112 paragraph 1, 37 C.F.R. § 1.152.

4. A copy showing the proposed corrections must be submitted for the Examiner's approval. Care should be exercised to avoid introduction of new matter. (35 U.S.C. 132; 37 CFR 1.118). Applicant is required to submit a proposed drawing correction in response to this Office action. However, actual correction of the formal drawings can be deferred until the application is allowed by the examiner.

Art Unit: 2901

correction of the formal drawings can be deferred until the application is allowed by the examiner.

5. The proposed amended illustration received 5/24/93, and the amendment to the specification received 5/7/97 have been entered, however the amendments introduce new matter (35 U.S.C. § 132, 37 C.F.R. § 1.118). Due to the differences between the original and new drawings and the lack of basis for the special description, applicant's disclosure fails to comply with the description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, the claim is rejected in that the disclosure does not satisfy the description requirement of 35 U.S.C. § 112, first paragraph. (In re Kaslow, 217 USPQ 1089 and In re Rasmussen, 211 USPQ 323.) The new matter is described as follows:

- a) The broken line drawing of a computer display shown in the drawing is considered new matter because there is no support nor suggestion for them in the original title, specification, or drawing. Although a broken line drawing represents unclaimed subject matter, any addition or deletion of subject matter from a drawing disclosure which is not supported nor suggested in the original disclosure is considered new matter.
- b) The special description added to the specification as directed by applicants' amendment received 5/7/97 is new matter because there is no support nor suggestion for a broken line illustration in this application. The original drawings do not show a broken line drawing anywhere, and the original

Art Unit: 2901

In an attempt to overcome this rejection, a proposed drawing must be submitted which overcomes the new matter as described above, and the special description must be cancelled from the specification. Note the rejection of the claim under 35 U.S.C. 171.

6. Since the rejection of the claim under 35 U.S.C. 112, first paragraph set forth above and should have been applied in the last office action, this action is non-final. As a result, the rejection of the claim under 35 U.S.C. 171 is repeated.

7. The claim again is rejected under 35 U.S.C. 171 as being directed to nonstatutory subject matter. 35 U.S.C. 171 defines the proper subject matter for a design patent:

Whoever invents any new, original and ornamental design for an *article of manufacture* may obtain a patent therefor, subject to the conditions and requirements of this title. [emphasis added]

To be considered statutory subject matter under 35 U.S.C. 171, a claimed design must be embodied in "an article of manufacture."¹ The phrase "an

¹In re Zahn, 617 F.2d 261, 268, 204 U.S.P.Q. 988, 995 (CCPA 1980).

Art Unit: 2901

article of manufacture" has been interpreted to be a tangible object or physical substance.²

8. A design may be embodied in an article of manufacture (1) as a configuration for an article of manufacture, (2) as a surface ornamentation for an article of manufacture, or (3) a combination of both. *Gorham v. White*, 81 U.S. 511, 525 (1871); *In re Schnell*, 46 F.2d 203, 209 (CCPA 1931); MPEP § 1502.

9. Pursuant to the guidelines for examination of design patent applications for computer generated icons³ a design for a computer generated icon may be considered statutory subject matter if the following conditions are present:

- 1) the computer screen, monitor, other display panel, or portion thereof is shown in broken or solid lines with the icon displayed on it, and
- 2) the claim is directed to the subject matter as embodied in an article of manufacture.

The subject matter of the instant application does not meet these conditions.

Consequently, a design for a computer generated icon per se is unpatentable

²See *Henry Hanger & Display Fixture Corp. of America v. Sel-O-Rak Corp.*, 270 F.2d 635,640, 123 U.S.P.Q. 3, 6 (5th Cir. 1959); *Pelouze Scale & Mfg. Co. v. American Cutlery Co.*, 102 F. 916, 918 (7th Cir. 1900). *Kim Craftsmen, Ltd. v. Astra Products, Inc.*, 212 U.S.P.Q. 268 (D.N.J. 1980); 1 E. Lipscomb, *Walker on Patents*, 2:11 (1984), 1 W. Robinson, *The Law of Patents*, 200 (1890).

³1185 O.G. 60, 61 F.R. 11380 (1996).


Art Unit: 2901

since it is not embodied in a specific article of manufacture.⁴ Be advised that the claim might be fatally defective; that is, it might not be possible to amend the specification, drawings and/or claim to meet the conditions set forth above without introducing new matter under 35 U.S.C. 112, first paragraph.

10. The claim is rejected under 35 U.S.C. 112, first paragraph; and again under 35 U.S.C. 171.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Tung, whose telephone number is (703)305-3105. The examiner can normally be reached on Tuesday-Friday from 7:30 to 5:00. The examiner can also be reached on alternate Mondays. The FAX phone number for this group is (703)308-2742. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-305-3293.

mht
August 4, 1997


M. H. TUNG
PRIMARY EXAMINER
ART UNIT 2901

⁴Ex parte Strijland, 26 U.S.P.Q.2d 1259 (BdPatApp & Inter 1992), Ex parte Tayama, 24 U.S.P.Q.2d 1614 (BdPatApp & Inter 1992), Ex parte Donoghue, 26 U.S.P.Q.2d 1266 (BdPatApp & Inter 1992); Ex parte Donoghue, 26 U.S.P.Q.2d 1271 (BdPatApp & Inter 1992), and Ex parte Donaldson, 26 U.S.P.Q.2D 1250 (BdPatApp & Inter 1992).